

Application No. 09/759,593
Amendment dated 4 August 2003
Reply to Communication of 2 July 2003

REMARKS

Claims 1 through 14, 17 through 23, and 38 through 46 are pending. Claims 15, 16, and 24 through 37 are canceled without prejudice. Applicants have the right to file a divisional application to recapture the subject matter of claims 15, 16, and 24 through 37.

Applicant appreciates the thoroughness of the Examiner's office action. Reconsideration is requested in light of the amendments above and the remarks below.

In the Specification & Drawings

Amendments to the specification have been made to correct minor spelling/grammatical errors, and to clarify the item numbers in Figures 5 and 6 that were duplicative to references in earlier portions of the specification. Figures 5 and 6 have been amended to correspond to changes made in the specification. A replacement sheet is attached.

Section 102 Issues

Claims 1 through 6, and 8 through 14 are rejected under 35 U.S.C. §102(b) as allegedly anticipated by United States Patent No. 5,652,008 to Heiligman (the '008 patent).

Applicant traverse the rejection and respectfully submits that the '008 patent does not anticipate the present invention. The identical invention must be shown in as complete detail as is contained in the... claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989).

Figure 1 of the '008 patent shows water filtration device **10** suspended across the opening **12** of container **14** using support member **89** that has a plurality of leg members **90** that extend radially from the support member (as shown in Figure 2). The plurality of leg members **90** sit on a rim of container **14** to suspend water filtration device **10** across the opening of the container. Water filtration device **10** is

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not supported upon a wall member of container **14**, but rather is supported across the rim of container **14** using the plurality of leg members **90**. Clearly, water filtration device **10** is not in contact with nor supported upon the wall member of the container or any compartment upon which water filtration device **10** can be used. Since the '008 patent does not contain all elements and limitations found in independent claim **1**, it cannot be anticipatory.

Dependent claims 2 through 6, and 8 through 14 are also not anticipated by the '008 patent since they contain all the elements and limitations of independent claim **1**, all of which are not found in the '008 patent.

Thus, Applicants respectfully request withdrawal of the rejection and allowance of claims 1 through 6, and 8 through 14.

Claim 7 is rejected under 35 U.S.C. §102(b) as allegedly anticipated by, or in the alternative, as allegedly obvious, under 35 U.S.C. §103(a), over United States Patent No. 5,652,008 to Heiligman.

Claim 7 depends from independent claim **1** and should be read to include all the elements and limitations of independent claim **1**. Since the '008 patent does not contain all elements and limitations found in independent claim **1**, it cannot anticipate dependent claim 7. Thus, Applicants respectfully request withdrawal of the rejection and allowance of claim 7.

With respect to the Examiner's alternative rejection under 35 U.S.C. §103(a), Applicants traverse the rejection and respectfully submit that if an independent claim is nonobvious under 35 U.S.C. §103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). There is no indication that claim **1** is rejected under 35 U.S.C. §103, and the '008 patent does not teach or suggest the invention of independent claim **1**. Since claim **1** is nonobvious, dependent claim 7 is nonobvious as well.

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Furthermore, the Examiner has not established a *prima facie* case of obviousness. There is no support in the law or the Manual of Patent Examining Procedure (MPEP) for the Examiner's assertion that mutilating the apparatus of the prior art reference, by snapping, cutting off, or otherwise removing the handle 72 shown in the '008 patent, renders obvious the claimed invention. Such a non-conforming use does not support a finding of obviousness. Applicants respectfully request withdrawal of the rejection and allowance of claim 7. Should the Examiner maintain this rejection, Applicants request that the Examiner point to explicit support shown in the MPEP or the Code of Federal Regulations for the rejection pursuant to MPEP 2144.03.

Even if, *in arguendo*, a *prima facie* case does exist, Applicants respectfully submit that the cited reference teaches away from the claimed invention. See MPEP 2144.05. The prior art must provide a motivation or reason for the worker in the art, without the benefit of [Applicants'] specification, to make the necessary changes in the reference device. *Ex parte Chicago Rawhide Mfg. Co.*, 223 USPQ 351 (Bd. Pat. App. & Inter. 1984). All drawings in the '008 patent show a fixed handle on the water filtration device. Furthermore, the '008 patent states that handle 72 is preferably molded, therefore permanently attached, to the center of the first planar horizontal mesh. See column 3, lines 14 to 22. There is nothing in the '008 patent that teaches or suggests the releasably attached handle of claim 7 or a modification thereof. Thus, Applicants respectfully request that all rejections of claim 7 be withdrawn and claim 7 pass to issuance.

Section 103 Issues

Claims 17 through 23 and 38 through 45 are rejected under 35 U.S.C. §103(a) as allegedly unpatentable over the combined teachings of United States Patent Nos. 5,652,008 and 5,393,548 (the '548 patent), both to Heiligman.

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Applicants traverse the rejection for the following reasons. The Examiner asserts that it would have been obvious to modify the device of the '008 patent within the compartment of a coffee maker in order to more securely position the filter. Alternatively, the Examiner asserts that it would have been obvious to modify the device of the '548 patent by incorporating the legs in order to more securely position the filter within the compartment. Either assertion is without merit. Should the device of the '008 patent be positioned in the brew basket of the coffee maker, it would render the coffee maker inoperable, or at the very least dangerous, because the device would sit on the rim of the brew basket inhibiting the coffee maker from closing properly or altering the position of the brew basket. In either situation, hot water would be spewing from the coffee maker creating a hazardous condition. Thus, the combination of the '008 patent and the '548 patent would effectively teach away from the present invention. As there is no basis or motivation in the cited prior art for combining the '008 patent and the '548 patent, Applicants respectfully submit that the Examiner has not established a *prima facie* case of obviousness, and the rejection should be withdrawn. Claims 17 through 23 and 38 through 45 should pass to issuance.

Claim 46 appears to be rejected under 35 U.S.C. §103 as allegedly being obvious in view of what is conventionally known in the art as modified by the '008 patent and the '548 patent. Applicants point out that the filter media used in the water filtration devices of the '008 patent and the '548 patent are both loose granular carbon or other granular materials. There is nothing to teach or suggest that a fused media is contemplated. Thus, claim 46 contains allowable subject matter and should pass to issuance.

Section 112 Issues

In the Office Action of 21 November 2002, claims 1 through 14 are rejected under 35 U.S.C. §112, second paragraph, as allegedly being indefinite for failing to

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point out and distinctly claim the subject matter that applicant regards as the invention.

Applicants have amended claim 1 in the response filed on 26 March 2003, such that the compartment and ingredients are placed in the preamble portion of the claim and are only referred to in the claim body, thereby more clearly indicating that the compartment and ingredients exist to flesh out the environment of the claimed invention, and are not part of the claimed invention. Therefore, given the amendment to claim 1, Applicants submit that the rejection under §112, second paragraph is obviated and the rejection be withdrawn.

However, in the Communication from the Examiner mailed 2 July 2003, the Examiner deemed Applicants' response to be non-responsive because Applicant "failed to clarify their position regarding the 112 rejection made". In a telephone interview with the Examiner, the undersigned pointed out that the compartment and ingredients are not intended to be part of the means for removing in claim 1. In an attempt to overcome the continuing 112 rejection, Applicants have amended claim 1 to more clearly state the relationship between the compartment, the ingredients, and the means for removing.

Applicants respectfully request reconsideration and allowance of claims 1 through 14, 17 through 23, and 38 through 46. Although the undersigned believes that no fees are required with this submission, please debit or credit Deposit Account No. 502371 with any fees associated with this response. Should there be any concerns or issues associated with the instant application that may be addressed

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by telephone, the Examiner is encouraged to call the undersigned at 203.799.9000
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Respectfully submitted,

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Date: 4 August 2003

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CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that the foregoing document is facsimile transmitted to the U.S. Patent &
Trademark Office, Washington, DC 20231, on the date set forth below.

Shirley S. Ma

4 August 2003

Shirley S. Ma

Name

Date

Signature